

## REMARKS

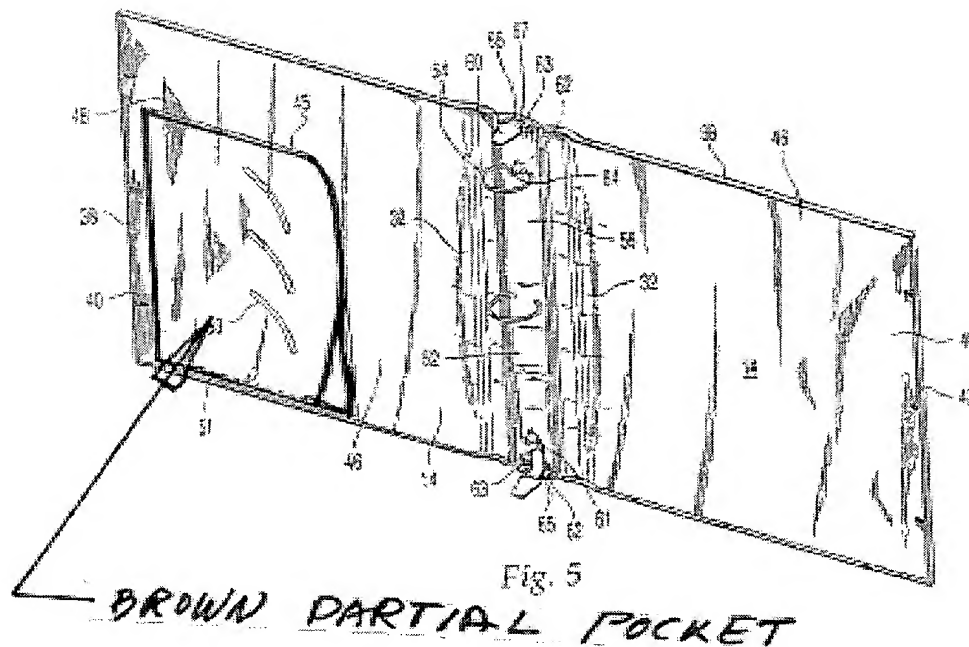
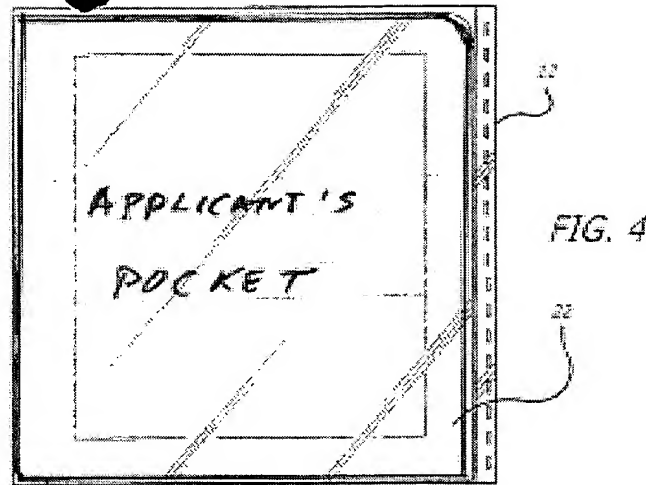
Applicant wishes to thank the Examiner for the telephone interview which took place on February 20, 2003.

Claims 1, 4-6, 11, 12, 14-17, 21, 22 and 24-28 are pending in the application. Claims 1, 4-6, 11, 12, 14-17, 21, 22 and 24-28 have been rejected under 35 U.S.C. § 103. Claims 1, 5, 11, 15, 17, 19, 21, 22 and 24 have herein been amended and are fully supported by the specification. Applicant has amended the claims to clarify the claim language. No new matter has been added to the amendment of this application. For at least the reasons stated below, Applicant asserts that all claims are in condition for allowance.

The claims as amended recite a large pocket on the inside of the cover to be at least coextensive with the framed open area or extending to the edges of the covers, so that the visual material is firmly held in-place against the transparent cover.

Before considering all of the 35 U.S.C. § 103 rejections, attention is respectfully directed to claim 11. Note that this claim previously called for an "insert having visual information applied thereto in the open area within said frame said insert being in said inner pocket." This limitation required the pocket to be coextensive with the open area in order for the insert to be within the inner pocket. This limitation has been emphasized by the amendment to the claim, explicitly stating that the pocket has an extent at least coextensive with the open area, and that it maintains the visual insert in engagement with the inner surface of the front cover.

The references applied to claim 11 were the Yamamoto '602 patent and the Brown '559 patent (FIG. 5). The claimed invention is distinguished from the Yamamoto '602 pocket because Yamamoto '602 is secured on three sides, whereas as the pocket of claimed invention is secured on only two sides. The claimed invention is distinguished from the Brown '559 pocket because Brown '559 is a small size pocket, whereas the pocket of the claimed invention is a large size pocket. The shape of the claimed invention and that of the pocket of Brown '559 can be better appreciated by comparing Applicant's FIG. 4 with Brown'559 FIG. 5, as shown below:



Now, first there is no teaching that the construction of Brown '559 should be combined with Yamamoto '602. Further, note from the above view of Brown '559, and Applicant's construction that, even if Brown '559 pocket were secured in the Yamamoto '602 binder (despite lack of teachings), that the result would not meet the claim language. Thus, if visual insert were placed in the Brown '559 pocket, it would be loose at the top and right hand side and could easily be folded over or torn so that it would not be visible through the front cover.

Accordingly, the proposed combination of references not only lacks any teachings for the combination, but also would not meet the language of the claim or the

spirit of the invention, involving ease of insertion and full support of the framed visual inserts against the transparent cover.

Following the foregoing specific analysis of the claim 11, a more general review of the rejections will be presented.

**I. 35 U.S.C. § 103 Rejections**

**A. Summary of the Prior Art**

**1. U.S. Patent No. 6,206,602 Yamamoto et al. (Yamamoto '602).**

Yamamoto '602 teaches a binder assembly comprising front and rear plastic covers, wherein the front cover is transparent with an opaque frame coating (FIG.2). The covers are secured by binding on three sides, thereby forming a pocket requiring insertion of materials from the one open side of the pocket cover; and such insertion may be difficult when light weight paper inserts are to be used.

Yamamoto '602 does not teach a flexible binder with a large inner pocket, secured on only two sides to the front cover- for ease of insertion of visual material. That is specifically an aspect of amended claim 1 as well as other amended independent claims. Further, Yamamoto '602 does not teach a flexible binder with a pocket secured on two sides to the rear cover. Again, this is claimed in the present invention.

**2. U.S. Patent No. 6,364,559 to Brown et al.(Brown '559).**

Brown '559 teaches a rigid binder having a partial inner pocket secured on two sides to the cover.

Brown '559 does not teach a flexible binder with a large inner pocket, secured on two sides to the front cover. That is claimed in the present invention.

**3. U.S. Patent No. 5,590,911 to Wilson (Wilson '911).**

Wilson '911 teaches a planning system assembled in a rigid binder and further comprising various dividers and "upwardly projecting index tabs (column 3, line 35)."

Wilson '911 does not teach a flexible binder comprising a large inner front pocket secured on two sides to the cover of the binder. Wilson '911 also does not teach a large pocket secured on two sides to the back cover of the binder. A large inner pocket on the front cover and a partial pocket on the back cover, both pockets being

secured on two sides to their respective covers, is claimed in the present invention, and neither taught nor suggested by Wilson '911.

**4. U.S. Patent No. 4,991,767 to Wyant (Wyant '676).**

Wyant '676 teaches a small pocket secured on two sides to the rear cover of a rigid binder. Further, Wyant '676 teaches several smaller sized pockets attached to the front cover.

Wyant '676 does not teach a flexible binder comprising a large inner front pocket secured on two sides to the cover of the binder. What Wyant '676 does not teach is claimed in the present invention.

**B. The pending claims are not obvious over Yamamoto '602 in view of Brown '559 and further in view of Wilson '911 and Wyant '767.**

Claims 1, 4-6, 11, 12, 14-17, 21, 22 and 24-28 are finally rejected under 35 U.S.C. § 103 as being unpatentable over Yamamoto '602 in view of Brown '559 and further in view of Wilson '911 and Wyant '767. Applicants respectfully traverse these rejections.

**1. There is no *prima facie* case of obviousness.**

MPEP § 2143 states that "[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art reference[s] must teach or suggest all the claim limitations.

**a. There is no suggestion or motivation to combine.**

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347 (Fed. Cir. 1992).

There is no motivation or suggestion to combine any of the cited references (Yamamoto '602 in view of Brown '559 and further in view of Wilson '911 and Wyant '767). For example, Yamamoto '602 does not teach that the 8 ½ x 11

transparent inner pocket can be secured on just two sides rather than on three sides as taught. The Examiner combines Yamamoto '602 in view of Brown '559 to teach a 8 ½ x 11 transparent inner pocket that is secured on two sides as that taught by Brown '559. However, Brown '559 describes "...a plastic pocket (45) that is heat sealed to one of the covers (14) and is open at the top...(column 3, lines 26-27). Brown '559 does not suggest or motivate one skilled in the art to make a pocket which is approximately the same size as that of the binder or 8 ½ x 11.

Similarly, there is no suggestion or motivation to combine Yamamoto '602 in view of Brown '559 with that of Wilson '911 (index tabs) and Wyant '767 (small pocket secured to the rear cover). That is, the references alone do not contemplate the claimed invention.

Furthermore, even if the references were to be combined, the MPEP 2143.01 states that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir., 1990). In the instant application, the cited prior art references do not suggest the combination.

Lastly, the notion that the claimed invention would have been " ' well within the ordinary skill of the art at the time the claimed invention was made ' " is not sufficient to establish a *prima facie* case of obviousness. That is, there must be some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ 1300 (Bd. Pat. & App. & Inter. 1993). In the instant application, there is no objective reason found in the references to combine the separate inventions to make the claimed invention.

Therefore, absent any suggestion or teachings in the references to combine, there is no *prima facie* case of obviousness.

**b. There is no reasonable expectation of success.**

MPEP 2143.02 states that "[t]he prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091 (Fed. Cir. 1986). In the present claims as amended, the visual material (i.e. paper insert) is firmly held against

the transparent cover on all four corners of the paper. With the proposed combination of prior art, the visual material inserts are not held firmly against the transparent cover because the pockets are small, and are not coextensive with at least the framed open area nor do they extend to the edges of the binder covers.

Thus, if the references were to be combined, the resulting invention is not the amended claimed invention. Therefore, there is no reasonable expectation of success and no *prima facie* case of obviousness.

**c. The prior art references do not teach or suggest all the claimed limitations.**

The MPEP § 2143 provides in part, "To establish a *prima facie* case of obviousness ... the prior art reference ... must teach or suggest all the Claim limitations." (emphasis added). The recent decision of the U.S. Court of Appeals Federal Circuit of In Re Lee, 61 USPQ2d 1430, is particularly pertinent to this issue. At page 1433 the Court addresses the purpose of the Administrative Procedure Act which requires administrative agencies, including the Patent Office, to not only have reached a sound decision, but to have articulated the reasons for that decision. This applies to patent prosecution in the office and before the board and subsequent review.

In addressing the issue of obviousness the Court noted that rejections under 35 USC § 103 must be based on evidence comprehended by language of the Section. The Court cites a series of cases requiring the showing of a suggestion, teaching or motivation to combine prior art references as an essential component to an obviousness holding. The Patent Office Board of Appeals in the Lee matter had rejected the need for any specific hint or suggestion in a particular reference to support the combination of prior art teachings. The Board had relied upon basic knowledge or common sense.

In essence, the CAFC required that there be evidence of the showing of a suggestion, teaching or motivation to combine the state of the art including what might be considered basic knowledge or common sense to combine or modify references. Because the cited references alone or in combination fail to teach or

suggest all of the Claim limitations, Applicants respectfully request that the Examiner's §103 rejections be withdrawn.

Thus, even if the Examiner had met the first two criteria for a *prima facie* case of obviousness, the combined references still do not teach all aspects of the claimed invention, and there is no *prima facie* case of obviousness. Briefly, aspects of the claimed invention is/are: i) semi-flexible binder; ii) the binder is comprised of semi-flexible front and rear covers; iii) an opaque frame defining an open area within the frame of the front cover; iv) an inner large pocket having approximately the same dimensions as the cover and secured on two sides, leaving open two sides for easy insertion of a visual document; v) a plurality of transparent dividers with outwardly projecting index tabs; and vi) a partial-pocket secured on two sides of rear cover of the binder.

The cited references do not teach all aspects of the claimed invention because: i) the pocket of Yamamoto '602 is secured on three sides, with the top being open to allow insertion of a visual document; ii) the pocket of Brown '559 B2 is not approximately the same size as the dimensions of the cover(s) of the binder; iii) the dividers of Wilson '911 do not teach dividers having outwardly projecting primary index tabs; and iv) all references do not teach a semi-flexible binder.

Thus, as stated above, "[T]o establish a *prima facie* case of obviousness ... the prior art reference ... must teach or suggest all the Claim limitations." (emphasis added) (MPEP § 214; *In Re Lee*, 61 USPQ2d 1430).

Furthermore, the MPEP in § 2143 states that "[t]o establish a *prima facie* case of obviousness, **three basic criteria must be met**: 1) that there must be some suggestion or motivation...to modify the reference or combine reference teachings; 2) that there must be reasonable expectation of success; and 3) that the prior art reference[s] must teach or suggest all the claim limitations.

Therefore, absent all three criteria above being met, there is no *prima facie* case of obviousness. Accordingly, Applicant respectfully requests that the rejections under 35 U.S.C. § 103 be withdrawn and the claimed invention allowed.

## **5. Declaration of Jay Sato: Fulfillment of a Long Felt Need**

Attention is further directed to the Declaration of Jay Sato, in which the shortcomings of the prior art are discussed. In addition, in paragraph 4, Mr. Sato reports that the product was only launched commercially late in 2002, and had sales of \$140,000 during its brief period of introduction; and Mr. Sato reports that customer interest and expectations for the product are high. By providing a binder which is easily personalized, and wherein the visual inserts are easily put in place, and reliably held in place, it is believed that the binders fulfill a long felt need, and this accounts for their commercial success and the continuing high level of interest in the products.

For completeness, paragraphs 7 and 10 of the Sata Declaration deserve special emphasis and are repeated here:

“7. It is further noted that the inserts are formatted so that when the inserts are mounted in the pocket with the pocket fully enclosing the insert, the visual part of the insert is properly centered or located in the assembly to show the desired image within the frame on the binder cover. Now, regarding the Brown et al. patent, the pocket 45 is said to be of “polypropylene film with slits 53 shaped to receive business cards”. Any loose leaf papers which might be randomly hold within pocket 45 would not be accurately positioned relative to the cover. This is in contrast to the present invention in which the pockets extend over the cover frame area, so that the pockets accurately position the formatted insert to be visible through the cover frame.”

“10. Accordingly, the complete binder of the claimed invention is clearly not suggested by these references, and the claimed invention appears to be satisfying a basic and long felt need for accurately holding visual inserts firmly in place to readily form a personalized cover binder. The differences from the prior art may be summarized as follows:

- (a) The Yamamoto prior art binder has pockets secured on three sizes, and is difficult to use.
- (b) The Brown prior art binder has only a partial pocket for mounting business cards.
- (c) The claimed full size pocket positions the formatted visual insert accurately located within the cover frame.



(d) The claimed full size pocket holds the visual insert against the cover across the entire area within the frame."

**6. Conclusion**

Claims 1, 4-6, 11, 12, 14-17, 21, 22 and 24-28 are pending in the application.

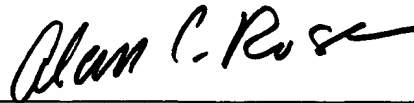
Claims 1, 4-6, 11, 12, 14-17, 21, 22 and 24-28 have been rejected under 35 U.S.C. § 103.

Claims 1, 5, 11, 15, 17, 19, 21, 22 and 24 have herein been amended and are fully supported by the specification. It is important to note that the amended claims do not add new matter, nor do they raise new issues. Thus, for example claims 1 and 11 state that the insert provided visual information in the open area within the frame, and that the insert was in the inner pocket. Accordingly, the pocket was necessarily larger than the open area; and this is now being emphasized with the amended claim language. That is, the claims have been amended to improve their form only and no further search should be required.

Applicant submits that all pending claims are allowable and respectfully requests that a Notice of Allowance be issued in this case. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (310) 788-5030.

A request for extension of time is hereby made for any necessary extensions of time pertaining to the present paper and any future papers in this case. The Commissioner is hereby authorized to charge any additional filing fees under 37 C.F.R. § 1.16, or application processing fees under 37 C.F.R. § 1.17, which may be required now or during the pendency of this application, or credit any overpayment to Account No. 16-2230 (Reference 310048-650199).

Respectfully submitted,



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Enclosed: Declaration of Jay Sato

## VERSION WITH MARKINGS TO SHOW CHANGES MADE

### IN THE CLAIMS

1. (Amended) A semi-flexible cover-view binder assembly, comprising:

front and rear semi-flexible plastic covers, said front cover being transparent and being provided with a peripheral coating forming a substantially opaque frame defining an open area within the frame; said covers having inner and outer surfaces;

an inner pocket having approximately the same dimensions as the cover secured to the inner surface of said front cover; said pocket having inner, outer, top and bottom edges; said inner pocket being secured along its outer edge and its bottom edge, and being free and unsecured to the cover at the top and inner edges, thereby permitting quick insertion of visual material from the top and inner edges of said pocket;

[an insert having visual information applied thereto in the open area within said frame, said insert being in said inner pocket;

a plurality of transparent dividers with tabs thereon mounted within said binder; and

said rear cover having a partial pocket extending for less than half of the area of said rear cover; said partial pocket being formed of the same sheet as the rear cover, with the pocket being formed by folding a sheet upward and bonding it in place, said rear cover being coated with substantially opaque material similar to the frame coating on the front cover.]

4. A binder assembly as defined in claim 1 wherein said [partial] pocket is transparent.

5. (Amended) A system including a binder assembly comprising:

a binder assembly comprising:

(a) front and rear semi-flexible plastic covers, said front cover being transparent and being provided with a peripheral coating forming a substantially opaque frame; said covers having inner and outer surfaces;

(b) an inner pocket having approximately the same dimensions as the cover secured to the inner surface of said front cover; said pocket having inner, outer, top and bottom edges; said inner pocket being secured along its outer edge and its bottom edge, and being free and unsecured to the cover at the top and inner edges, thereby permitting quick insertion of visual material from the top and inner edges [areas] of said pocket;

(c) an insert having visual information applied thereto in the area within said frame, said insert being in said inner pocket;

(d) a plurality of transparent dividers with outwardly projecting tabs thereon mounted within said binder; and

(e) said rear cover having a partial pocket extending for less than half of the area of said rear cover; said partial pocket being formed of the same sheet as the rear cover, with the pocket being formed by folding a sheet upward and bonding it in place, said rear cover being coated with substantially opaque material similar to the frame coating on the front cover; and

said system further including a computer, a keyboard and a printer, for displaying the framed front cover of said binder and forming visual material within said frame, and printing out the visual insert for insertion into the inner pocket with the visual material set-off and enclosed by said frame.

6. A binder assembly as defined in claim 1 wherein said rear cover partial pocket has a plurality of slits therein for mounting cards on said partial pocket.

11. (Amended) A semi-flexible cover-view binder assembly, comprising:

front and rear semi-flexible plastic covers, said front cover being transparent and being provided with a peripheral substantially opaque frame

defining an open area within the frame; said covers having inner and outer surfaces;

an inner pocket secured to the inner surface of said front cover; said pocket having inner, outer, top and bottom edges; said inner pocket being secured along its outer edge and its bottom edge, and being free at the top and inner edges, thereby permitting quick insertion of visual material from the top and inner edges of said pocket; [and]

an insert having visual information applied thereto in the open area within said frame, said insert being in said inner pocket[.]; and

said pocket having an extent [greater than]at least coextensive with [and overlying] said open area;

whereby said pocket maintains said visual material in engagement with the inner surface of said front cover, with the visual material located within the open area of the frame.

12. a binder assembly as defined in claim 11 wherein said rear cover has a rear pocket of the same material as the said rear cover; said rear pocket being formed of the same sheet as the rear cover, with the pocket being formed by folding said sheet and bonding it in place.

14. A binder assembly as defined in claim 11 wherein said rear pocket is transparent.

15. (Amended) A system including a binder assembly comprising:

a binder assembly comprising:

(a) front and rear semi-flexible plastic covers, said front cover being transparent and being provided with a peripheral coating forming a substantially opaque frame; said covers having inner and outer surfaces;

(b) an inner pocket having approximately the same dimensions as the cover secured to the inner surface of said front cover; said pocket having inner, outer, top and bottom edges; said inner pocket being secured along its outer edge and its bottom edge, and being free and unsecured to the cover at the top and inner edges, thereby permitting quick insertion of visual material from the top and inner edges [areas] of said pocket;

(c) an insert having visual information applied thereto in the area within said frame, said insert being in said inner pocket;

(d) a plurality of transparent dividers with outwardly projecting tabs thereon mounted within said binder; and

(e) said rear cover having a partial pocket extending for less than half of the area of said rear cover; said partial pocket being formed of the same sheet as the rear cover, with the pocket being formed by folding a sheet upward and bonding it in place, said rear cover being coated with substantially opaque material similar to the frame coating on the front cover; and

said system further including a computer, a keyboard and a printer, for displaying the framed front cover of said binder and forming visual material within said frame, and printing out the visual insert for insertion into the inner pocket with the visual material set-off and enclosed by said frame.

16. A binder assembly as defined in claim 11 wherein said rear cover is opaque and wherein it has a coating to substantially match the frame on the front cover.

17. (Amended) A semi-flexible cover-view binder assembly, comprising:

front and rear semi-flexible plastic covers, said front cover being transparent and being provided with a peripheral substantially opaque frame defining an open area within the frame; said covers having inner and outer surfaces;

an inner pocket having approximately the same dimensions as the cover secured to the inner surface of said front cover; said pocket having inner, outer, top and bottom edges; said inner pocket being secured along its outer edge and its bottom edge, and being free at the top and inner edges, thereby permitting quick insertion of visual material from the top and inner areas of said pocket;

an insert having visual information applied thereto in the open area within said frame, said insert being in said inner pocket;

a plurality of dividers with outwardly projecting tabs thereon mounted within said binder; and

said rear cover having a rear pocket formed of the same sheet as the rear cover.

19. (Amended) A system including a binder assembly comprising:

a binder assembly comprising:

(a) front and rear semi-flexible plastic covers, said front cover being transparent and being provided with a peripheral coating forming a substantially opaque frame; said covers having inner and outer surfaces;

(b) an inner pocket having approximately the same dimensions as the cover secured to the inner surface of said front cover; said pocket having inner, outer, top and bottom edges; said inner pocket being secured along its outer edge and its bottom edge, and being free and unsecured to the cover at the top and inner edges, thereby permitting quick insertion of visual material from the top and inner edges [areas] of said pocket;

(c) an insert having visual information applied thereto in the area within said frame, said insert being in said inner pocket;

(d) a plurality of transparent dividers with outwardly projecting tabs thereon mounted within said binder; and

(e) said rear cover having a partial pocket extending for less than half of the area of said rear cover; said partial pocket being formed of the same sheet as the rear cover, with the pocket being formed by folding a sheet upward and bonding it in place, said rear cover being coated with substantially opaque material similar to the frame coating on the front cover; and

said system further including a computer, a keyboard and a printer, for displaying the framed front cover of said binder and forming visual material within said frame, and printing out the visual insert for insertion into the inner pocket with the visual material set-off and enclosed by said frame.

21. (Amended) A semi-flexible cover-view binder assembly, comprising:

front and rear semi-flexible plastic covers, said front cover being transparent and being provided with a peripheral substantially opaque frame defining an open area within the frame; said covers having inner and outer surfaces;

an inner pocket having approximately the same dimensions as the cover secured to the inner surface of said front cover; said inner pocket being secured along three edges with the semi-flexible covers of said binder assembly permitting quick insertion of visual material into said pocket; and

an insert having visual information applied thereto in the open area within said frame, said insert being in said inner pocket.

22. (Amended) A semi-flexible cover-view binder assembly, comprising:

front and rear semi-flexible plastic covers, said front cover being transparent and being provided with a peripheral substantially opaque frame defining an open area within the frame; said covers having inner and outer surfaces;

an inner pocket having four edges and has approximately the same dimensions as the cover secured to the inner surface of said front cover; said

inner pocket being secured to the front cover along two edges, and the other two edges being free and unsecured to the front cover, thereby permitting quick insertion of visual material from the other two edges of said pocket; and

an insert having visual information applied thereto in the open area within said frame, said insert being in said inner pocket.

24. (Amended) In combination:

a semi-flexible cover-view binder assembly, comprising:

(a) front and rear semi-flexible plastic covers, said front cover being transparent and being provided with a peripheral substantially opaque frame defining an open area within the frame; said covers having inner and outer surfaces;

(b) an inner pocket having the approximately the same dimensions as the cover secured to the inner surface of said front cover; said pocket having inner, outer, top and bottom edges; said inner pocket being secured along its outer edge and its bottom edge, and being free at the top and inner edges, thereby permitting quick insertion of visual material from the top and inner edges of said pocket;

(c) an insert having visual information applied thereto in the open area within said frame, said insert being in said inner pocket; and

a computer, a keyboard and a printer, for displaying an image corresponding to the framed front cover of said binder, for forming visual material within the frame, and for printing out the visual insert for insertion into the inner pocket of said binder assembly with the visual material set-off and enclosed by said frame.

25. (To take the place of Claim 2) A binder assembly as defined in claim 1 wherein said covers are secured together at a binding and wherein said inner pocket is formed of a sheet which is secured to said binding, and is cut along the binding to form the inner free edge of said pocket.



26. (To take the place of Claim 13) A binder assembly as defined in claim 11 wherein said covers are secured together at a binding and wherein said inner pocket is formed of a sheet which is secured to said binding, and is cut along the binding to form the inner free edge of said pocket.

27. (To take the place of Claim 18) A binder assembly as defined in claim 17 wherein said covers are secured together at a binding and wherein said inner pocket is formed of a sheet which is secured to said binding, and is cut along the binding to form the inner free edge of said pocket.

28. An assembly as defined in claim 17 wherein said inner pocket extends over the greater portion of the inner surface of said front cover.